REMARKS

Applicant appreciates the Examiner's consideration and entry of the Response/Amendment After Final dated November 27, 2006 (the "previous Response"). Applicant also appreciates the Examiner's courtesy in discussing the Advisory Action over the telephone on December 28, 2006.

The Alleged Insufficiency of the Declaration and Exhibit:

The Advisory Action asserts that the Exhibit, which was submitted with a Declaration on August 16, 2006, "fails to meet the requirements set forth ... under 37 C.F.R. 1.131." Specifically, the Advisory Action asserts that the Declaration and Exhibit are "insufficient to prove conception" because Applicant must explain how the claims are related to the Exhibit.

In pertinent part, 37 C.F.R. § 1.131 states as follows:

> (a) When any claim of an application ... is rejected, the inventor ... may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference ... on which the rejection is based....
>
> (b) The showing of facts shall be such, in character and weight, as to establish ... conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained. (Emphasis added.)

Thus, 37 C.F.R. § 1.131 states that an exhibit "must accompany" the Declaration, as supporting evidence, or absence of the exhibit must be explained. However, 37 C.F.R. § 1.131 does not state that the Declaration must specifically explain how the claims are related to the Exhibit, particularly when the relevance is self evident. Instead, the standard established by 37 C.F.R. § 1.131 simply requires

that the "showing of facts shall be such, in character and weight, as to establish ... conception of the invention prior to the effective date of the reference."

In accordance with 37 C.F.R. § 131(b), Applicant provided a photocopy of the original Invention Disclosure Form (IDF) record as an Exhibit with the Declaration. In addition, the Declaration specifically refers to the IDF.

In this case, the claims are relatively short and clear, and the Exhibit is organized in such a manner as to make its relevance to the claims self evident. For instance, the Exhibit is fairly succinct, and does not exceed four pages. Moreover, the Exhibit includes obvious headings that indicate (a) which sections of the Exhibit pertain to the features of the invention, (b) which sections pertain to the names of the inventors, etc.

Nevertheless, to avoid further expense and delay, Applicant hereby explains how the claims are related to the Exhibit, as follows:

Claims 1, 8, 11, 13, and 18 are the independent claims. Claim 1 recites a method comprising:

- initializing a processing system according to predetermined basic input/output system (BIOS) settings for the processing system;
- booting an operating system (OS) on the processing system; and
- providing a virtual runtime interface that allows a user to modify the BIOS settings for the processing system after the OS has been booted.

These features are reflected in at least the following sections of the Exhibit:

- Section 1 of the Exhibit, on pages 2 and 3 (under the heading "**Describe in detail what the components of the invention are and how the invention works**");
- Section 2 of the Exhibit, on page 4 (under the heading "**Describe advantage(s) of your invention over what is currently being done**");
- Section 4 of the Exhibit, on page 4 (under the heading "**Value of your invention to Intel**"); and
- Section 5 of the Exhibit, on page 4 (under the heading "**Explain how your invention is novel**").

For instance, Section 4 discusses "the ability to configure the platform at any time;" Section 5 includes that statement that "[t]his is the first time that platform configuration can be seamlessly integrated into the system without perturbing the surrounding environment;" and Section 1 include various implementation details, such as an "Operating System Running" after "Firmware Initialization [is] Complete," and a "Runtime Monitor SMI/PMI Handler" to handle requests such as "initiating platform setup during the O/S runtime."

Claim 8 involves an apparatus with instructions that cause a processing system to perform operations comprising: providing a virtual runtime interface after the processing system has booted to an operating system (OS), wherein the virtual runtime interface allows a user to modify basic input/output system (BIOS) settings for the processing system, and wherein the virtual runtime interface provides a graphical user interface (GUI) that accepts user input data.

Like claim 1, the claim 8 is reflected sections of the Exhibit such as Section 1, Section 2, Section 4, and Section 5. For instance, in Section 1, the illustration in the upper right corner on page 2 depicts a GUI, and the legend for that illustration states that "[t]his art describes an event that can be initiated so that an out-of-band version of a firmware-based platform setup can be executed so platform configuration can take place any time during the system evolution."

Claim 11 involves an apparatus with instructions that cause a processing system to perform operations comprising:

- providing a virtual runtime interface after the processing system has booted to an operating system (OS), wherein the virtual runtime interface allows a user to modify basic input/output system (BIOS) settings for the processing system;
- receiving user input data through the virtual runtime interface, wherein the user input data specifies a modified BIOS setting; and
- saving the modified BIOS setting to be implemented upon a subsequent initialization of the processing system.

Like claim 1, the claim 11 is reflected sections of the Exhibit such as Section 1, Section 2, Section 4, and Section 5. For instance, the second paragraph of Section

1 states that "the firmware will proxy configuration requests and post them to the appropriate non-volatile store."

Claim 13 involves an apparatus with instructions that cause a processing system to perform operations comprising:

- detecting a BIOS configuration trigger event after the processing system has booted to an operating system (OS); and
- in response to detecting the BIOS configuration trigger event, automatically providing a virtual runtime interface that allows a user to modify basic input/output system (BIOS) settings for the processing system.

These features are reflected in at least the following sections of the Exhibit:

- Section 1 of the Exhibit, on pages 2 and 3 (under the heading "**Describe in detail what the components of the invention are and how the invention works**");
- Section 2 of the Exhibit, on page 4 (under the heading "**Describe advantage(s) of your invention over what is currently being done**");
- Section 4 of the Exhibit, on page 4 (under the heading "**Value of your invention to Intel**"); and
- Section 5 of the Exhibit, on page 4 (under the heading "**Explain how your invention is novel**").

Like claim 1, the claim 13 is reflected sections of the Exhibit such as Section 1, Section 2, Section 4, and Section 5. For instance, in Section 1, the flowchart on the top half of page 2 depicts operations for determining "Has an event been triggered?," displaying a "user interface to [the] screen," and "[i]nteract and proxy requests from user to configure platform."

Claim 18 involves a processing system comprising:

- a processor;
- memory communicatively coupled to the processor;
- basic input/output system (BIOS) settings stored in the memory; and

- instructions stored in the memory, wherein the instructions, when executed by the processor, cause the processing system to perform operations comprising:
- detecting a BIOS configuration trigger event after the processing system has booted to an operating system (OS); and
- in response to detecting the BIOS configuration trigger event, automatically providing a virtual runtime interface that allows a user to modify the BIOS settings for the processing system.

Like claim 1, the claim 18 is reflected sections of the Exhibit such as Section 1, Section 2, Section 4, and Section 5. For instance, in Section 1, the flowchart on the top half of page 2 depicts operations for determining "Has an event been triggered?," displaying a "user interface to [the] screen," and "[i]nteract and proxy requests from user to configure platform." Also, the flowchart on the bottom half of page 2 depicts operations such as "[c]all Runtime Monitor, upon return Exit SMM back to O/S context."

It should now be abundantly clear that the Declaration and Exhibit do indeed provide a showing of facts in such character and weight as to establish conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to the filing of the application. Applicant has therefore met the requirements of 37 C.F.R. § 1.131.

Consequently, European patent application no. 02354066.9 to Paul Neuman et al. (hereinafter "Neuman") is not a valid reference under 35 U.S.C. §§ 102(a) and 103(a). The rejections under 35 U.S.C. § 102(a) and 103(a) should therefore be withdrawn.

The Alleged Informalities in Certain Claims:

The Office Action dated October 12, 2006, (the "Office Action") objects to claims 2-7, 9-10, 12-17, and 19-21 due to alleged informalities. The Advisory Action does not indicate whether or not those objections have been withdrawn. Applicant's previous Response amended the claims in accordance with the suggestions in the

Office Action. Applicant requests confirmation that those objections have been withdrawn.

The Rejections under 35 U.S.C. § 101:

The Office Action rejects claims 8-17 under 35 U.S.C. § 101 as being directed to unpatentable subject matter. Applicant's previous Response amended the claims in accordance with the advice from the Office Action. Applicant requests confirmation that those rejections have been withdrawn.

The Rejections under 35 U.S.C. § 102(a):

The Office Action rejects claims 1-3 and 18-19 under 35 U.S.C. § 102(a) as being anticipated by Neuman. Under Section 102(a), Applicant is entitled to a patent unless "the invention was ... described in a printed publication in ... a foreign country, before the invention thereof" by Applicant. The publication date of Neuman was October 29, 2003 (hereinafter the "Reference Date").

As indicated in the response to two previous Office Actions, the present invention was conceived before that Reference Date and thereafter filed as a patent application with due diligence. Furthermore, a Declaration and associated evidence providing additional facts concerning the date of conception and due diligence were filed with the response to the first Office Action. The declaration and evidence show that the invention was not described in a printed publication in a foreign country, before the invention thereof by Applicant.

As indicated above, the IDF provides more than ample evidence to show that the inventors conceived of the inventions recited in the pending independent claims of the present application before the Reference Date, in accordance with 37 C.F.R. § 1.131.

For at least the foregoing reasons, the rejections under 35 U.S.C. § 102(a) should be withdrawn.

The Rejections under 35 U.S.C. § 103(a):

The Office Action rejects claims 4 and 20 as being unpatentable over Neuman in view of U.S. patent no. 6,823,451 to Dale E. Gulick et al. (hereinafter "Gulik"). However, as indicated above, Nueman does not constitute prior art, in light of the Declaration and IDF submitted earlier. For at least the foregoing reason, the rejections under 35 USC § 103(a) should be withdrawn.

CONCLUSION

For all of the foregoing reasons, reconsideration of the present application is respectfully requested.

In addition, Applicant requests clarification regarding whether or not the objections and rejections under 35 U.S.C. § 101 have been withdrawn, since the Advisory Action did not provide that information.

If the Examiner has any questions, the Examiner is invited to contact the undersigned at (512) 732-3927.

Respectfully submitted,

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